



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Paper No. 31

TEXAS INSTRUMENTS INCORPORATED
P O BOX 655474, M/S 3999
DALLAS TX 75265

COPY MAILED

FEB 17 2005

OFFICE OF PETITIONS

In re Application of:
Thrift et al.
Application No. 08/419,229
Filed: April 10, 1995
Docket No.: TI-20205

:
:
: ON PETITION
:
:
:

The above-identified application has been referred to this office to treat the petition to expunge under 37 CFR 1.59 filed May 4, 2004.

The petition is **dismissed**. This is not a final agency action.

BACKGROUND

A review of the record reveals that the instant application has been subjected to appellate review, reported as *In re Thrift*, 298 F.3d. 1357, 63 USPQ2d 2002 (Fed. Cir. 2002), in which the Federal Circuit affirmed the decision of the Board of Patent Appeals and Interferences with respect to claims 1-10, but vacated the Board's decision affirming the examiner's rejection under 35 U.S.C. § 103(a) with respect to claims 11-19, and remanded for further proceedings with respect to those claims. The Board, in turn, remanded the application to the examiner on January 17, 200, for appropriate action consistent with the decision of the court. The remand noted (at 3-4), *inter alia*, that the language of claims 11 through 19 was presented in "means-plus-function" format, which entails interpretation as being limited to the corresponding structure described in the specification or equivalents thereof. The remand went on:

The Examiner must therefore determine the precise scope of the appealed claims consistent with 35 U.S.C. § 112, sixth paragraph, and must consider how the art of record and any newly discovered prior art, may be applicable to the determination of the patentability of properly construed claims 11-19.

The examiner reopened prosecution in the final Office action of September 25, 2003. While the aforementioned Office action contained newly instituted rejections of the claims under 35 U.S.C. § 112, first and second paragraphs, the action did not contain any rejection of the claims under § 103(a). Further, the action did not contain any

determination of the precise scope of the claims consistent with § 112, sixth paragraph. A Notice of Allowance, and a Notice of Allowability were mailed December 30, 2003. The Notice of Allowability referenced and included an Interview Summary memorializing several telephone conversations between counsel for applicants and the Group Director, Technology Center 2600 that occurred in November and December 2003. The Summary recounted that the Group Director agreed with counsel that the above-noted rejections should be withdrawn, and further, that the Group Director indicated that unless the examiner had present knowledge of the existence or a particular reference(s) negating patentability, this application was to be passed to issue.

The issue fee payment was timely filed March 1, 2004.

On March 23, 2004, a second Notice of Allowability was mailed. This correspondence asserted that the record was incomplete *vis-a-vis* the Board's remand directive to determine the scope of the means-plus-function language and to provide an analysis of the thus-construed claims in light of the prior art. The correspondence went on to define the scope of the means plus function elements of the claims in light of the corresponding structure or acts found in the specification.

On May 4, 2004 applicants filed a paper captioned as "Objection to Communication [mailed March 23, 2004],," and on the same date filed the instant petition to expunge.

OPINION

Petitioners request that part of the Office communication mailed March 23, 2004 be expunged as such is asserted to be improper and lacking compliance with MPEP 1302.14. Specifically, petitioner contends, the examiner was without authority to reopen prosecution and restrict the scope of the claims.

37 CFR 1.59 provides for the applicant's request for expungement of information in a patent application, other than the original papers upon which the filing date was granted. However, under the terms of the rule, petitioner "must ...establish to the satisfaction of the Director that the expungement of the information is appropriate..." See 37 CFR 1.59(b). Under the circumstances of this case, petitioner has not met his burden of proof.

Given the longstanding USPTO policy that the administrative record of any application file should accurately reflect its prosecution history, a revision or expungement of an Office communication would only be justified where that Office communication contained inappropriate statements that were not suitable for retention in the administrative record. Cf. 37 CFR 1.3, which requires that applicants must conduct their business with the USPTO with decorum and courtesy. Inspection of the Notice of Allowability of March 23, 2004, does not reveal that it contains any inappropriate statements that are, *per se*, unsuitable for retention in the administrative record of this application. While petitioners may disagree with the examiner's findings of fact and conclusions set forth in the contested communication, a mere difference of opinion

does not justify the requested revision or expungement of the communication in whole or in part.¹

37 CFR 1.104(e) specifically sets forth that "[i]f the examiner believes that the record of the prosecution as a whole does not make clear his or her reasons for allowing a claim or claims, the examiner may set forth such reasoning. The reasons shall...be the subject of a separate communication to the applicant..." There is nothing in this regulation that requires the examiner to make his statement of reasons for allowance while prosecution is open, or that requires the examiner to reopen prosecution to make his statement if prosecution has been previously closed. Indeed, inspection of MPEP 1302.14, which speaks to USPTO policy regarding examiner's statements of reasons of allowance, gives as an example of when it is likely that a statement should be added to the record, the specific instance "(d):[a]llowance after remand from the Board of Patent Appeals and Interferences." Thus, where, as here, an application is allowed after remand from the Board, the USPTO considers a statement of reasons of allowance to be a likely occurrence.

Furthermore, while the examiner's belated determination of the scope of the means-plus-function elements is asserted to have improperly "reopened" prosecution, the record simply does not support petitioner's conclusion. The office action of September 25, 2003, clearly reopened prosecution to apply new rejections under 35 U.S.C. § 112, first and second paragraphs, and just as clearly, the Group Director has vacated those rejections as untenable. Thus, prosecution remained closed. The allegedly improper narrowing construction of the means-plus-function elements of the claims of which petitioner complains was not a rejection of those claims. See In re Volk, 207 USPQ 1086, 1088 (CCPA 1980)(examiner's refusal to construe claims as broadly as applicant desired is not a rejection of those claims conferring jurisdiction for appellate review.)

Accordingly, since the construction given in the Notice of Allowability of March 23, 2003, of the means-plus-function elements was not a rejection, there is no basis given by petitioner or apparent from the record to support the contention that prosecution was reopened. Likewise, the mere fact that petitioner disagrees with the examiner's construction of the claims is not seen to be sufficient grounds for expungement of the construction of which petitioner complains. See Volk at 1087(recounting that the Commissioner dismissed Volk's petition to expunge the examiner's narrowing construction.) Since the USPTO considers it likely that an application allowed after a Board remand will contain a statement of reasons for allowance, petitioner has failed to show why the inclusion of such was an abuse of discretion on the examiner's part. The Board made it clear in its remand that the examiner had not construed the claims in

¹ In Lear, Inc. v. Adkins, 395 U.S. 653, 670, 162 USPQ 1, 8 (1969), Justice Harlan, writing for the Court, observed:

A patent, in the last analysis, simply represents a legal conclusion reached by the Patent Office. Moreover, the legal conclusion is predicated on factors as to which reasonable men can differ widely.

question on the record. As noted in MPEP 1304.14, it is incumbent upon the examiner in exercising his or her responsibility to the public, to see that the file history is as complete as is reasonably possible. Furthermore, petitioners do not show that the examiner committed clear error in his listing of the specific sections of the specification that the examiner attributed to the various means-plus-function elements in his construction of the claims. Even assuming *arguendo* that the examiner erred in his listing or if the examiner overlooked other relevant specification disclosure, applicants are permitted by the express language of 37 CFR 1.104(e) to file a statement commenting on the reasons for allowance. Lastly, as the court noted in Volk at 1088:

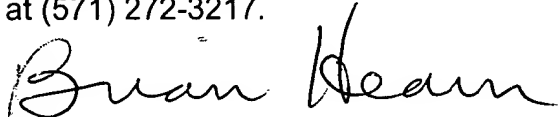
If an examiner's narrowing construction of the claims suggests a need for broader claim language, an applicant may present broader claims and obtain a ruling on the validity of those broadened claims.

DECISION

For the reasons given above, applicants have not established to the satisfaction of the Director that expungement of the contested material is appropriate within the meaning of 37 CFR 1.59(b). Accordingly, the contested material will not be expunged.

This application is being returned to Technology Center 2600, Office of the Group Director, for consideration of the communication filed May 4, 2004, captioned "Objection to Communication From Examiner Purporting To Correct An Incomplete Record Of The Application-Mailed After the Issue Fee Paid."

Telephone inquiries related to this communication should be directed to the undersigned at (571) 272-3217.



Brian Hearn
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner for
Patent Examination Policy